

- (a) receiving one of a broadcast and a cablecast information transmission containing at least one control signal;
- (b) selecting at least one of a television, radio, print, and multimedia program and transferring said at least one of a television, radio, print, and multimedia program to said output device for delivery to a user;
- (c) detecting at least a first of said at least one control signal in said information transmission and passing said detected at least said first of said at least one control signal to said computer;
- (d) generating at least a first receiver specific datum by processing information stored in said computer in response to at least said first of said at least one control signal;
- (e) communicating at least said first receiver specific datum to said output device; and
- (f) ceasing to communicate said at least a first receiver specific datum to said output device.

3. (Unchanged) The method of claim 2, further comprising the step of receiving said at least one of a television, radio, print, and multimedia program from a remote station.

4. (Unchanged) The method of claim 2, further comprising the steps of:

- generating at least a second receiver specific datum;
- detecting at least a second at least one control signal and passing said at least a second instruct signal to said computer; and
- delivering at said output device a second one of a combined and a sequential output of said program and said at least a second receiver specific

datum by controlling said computer to communicate said at least a second receiver specific datum to said computer in response to said at least a first of said at least one control signal.

5. (Unchanged) The method of claim 2, further comprising the steps of:

storing said at least one of a television, radio, print, and multimedia program on a programming storage device;

retrieving said at least one of a television, radio, print and multimedia program from said programming storage device and communicating said at least one of a television, radio, print, and multimedia program in an information transmission; and

detecting one of said at least a first of said at least one control signal and at least one further instruct signals in said information transmission;

passing at least one of said first at least one control signal and said second at least one control signal to said computer; and

controlling said computer in response to said said at least one of said at least one control signal and said second at least one control signal.

6 (Twice Amended) A method of controlling a remote intermediate mass medium program transmitter station to communicate mass medium program material to a remote receiver station and controlling said remote receiver station to deliver an individualized mass medium program presentation, said method comprising the steps of:

receiving mass medium programming and delivering said medium programming to an origination transmitter;

receiving at least one instruct signal at said remote intermediate mass medium transmitter station, said at least one instruct being operable at said remote receiver station to generate at least one receiver specific datum for presentation in a specific type of programming presentation;

receiving at least one control signal at said remote intermediate mass medium transmitter station, said at least one control signal being operable at said remote intermediate mass medium transmitter station to control communication of at least a portion of said mass medium programming and said at least one instruct signal; and

transmitting from said remote intermediate mass medium transmitter [section] station at least one information transmission containing said at least a portion of said mass medium programming and said at least one instruct signal, at least said portion of said mass medium programming and said at least one instruct signal being transmitted in accordance with said at least one control signal.

7. (Unchanged) The method of claim 6, wherein said at least a portion of said mass medium program comprises at least one of audio and text.

8. (Unchanged) The method of claim 6, wherein said at least a portion of said mass medium program comprises a television program.

9. (Unchanged) The method of claim 6, wherein said at least one instruct signal comprises downloadable code.

10. (Unchanged) The method of claim 6, wherein at least one of (i) said at least one control signal includes at least one scheduled time of transmitting

said mass medium programming from said remote intermediate mass medium program transmission station and (ii) said at least one control signal is effective at said remote intermediate mass medium program transmission station to control at least one selective transfer devices at a plurality of times.

11. (Unchanged) A method of controlling a remote intermediate transmitter station to communicate at least one instruct signal to at least one receiver station, said remote intermediate transmitter station including at least one of a broadcast and a cablecast transmitter, a plurality of selective transfer devices each operatively connected to said at least one of said broadcast and said cablecast transmitter, a receiver for receiving said at least one instruct signal from at least one origination transmitter station, a control signal detector, and one of a controller and a computer capable of controlling at least one of said plurality of selective transfer devices, said remote intermediate data transmitter station being adapted to detect at least one control signal, to control the communication of at least one instruct signal in response to said at least one control signal, and to deliver at said at least one of said broadcast and said cablecast transmitter said at least one instruct signal, said method comprising the steps of:

receiving said at least one instruct signal at said at least one origination transmitter station and delivering said at least one instruct signal to at least one origination transmitter, said at least one instruct signal being effective at said at least one receiver station to generate at least one receiver specific datum for presentation in a specific type of programming presentation;

receiving said at least one control signal which at said remote intermediate data transmitter station controls communication of said at least one instruct signal; and

transmitting said at least one control signal from said at least one origination transmitter before a specific time.

12. (Unchanged) The method of claim 11, further comprising the step of embedding a specific one of said at least one control signal in one of said at least one instruct signal and in an information transmission containing said at least one instruct signal before transmitting said at least one instruct signal to said remote intermediate transmitter station.

13. (Unchanged) The method of claim 11, wherein said specific time is a scheduled time of transmitting one of said at least one instruct signal and some information associated with said at least one instruct signal from said remote intermediate transmitter station, and said at least one control signal being effective at said remote intermediate transmitter station to control at least one of said plurality of selective transfer devices at different times.

14. (Unchanged) A method of controlling at least one of a plurality of receiver stations each of which includes a mass medium program receiver, a signal detector, at least one of a computer, and a processor, each one of said plurality of receiver stations being adapted to detect the presence of at least one control signal and to input a viewer reaction to a specific offer communicated in a mass medium program, said method comprising the steps of:

receiving an instruct signal at a transmitter station and delivering said instruct signal to at least one transmitter, said instruct signal being effective at said at least one of said plurality of receiver stations to generate at least one receiver specific datum for presentation in a specific type of programming presentation;

receiving at least one of code and a datum at said transmitter station, said at least one of said code and said datum designating at least one of said at least one instruct signal and said viewer reaction;

receiving at least one control signal at said transmitter station, said at least one control signal being effective at said at least one of said plurality of receiver stations to at least one of identify and select at least one of said at least one instruct signal;

transferring (i) said at least one of said code and said datum and (ii) said at least one control signal to said at least one transmitter; and

transmitting said at least one instruct signal, said at least one of said code and said datum and said at least one control signal from said transmitter station.

15. (Unchanged) The method of claim 14, wherein at least one of said at least one control signal, said code and said datum is embedded in one of a television signal and in a signal containing a television program.

16. (Unchanged) The method of claim 14, wherein said at least one control signal is effective to output a viewer order for at least one of a product and a service, said method further comprising the steps of communicating to said transmitter and transmitting some information which is effective at said receiver station to at least one of select and assemble specific information to communicate to said remote data collection site.

17. (Unchanged) The method of claim 14, wherein said at least one control signal includes downloadable code.

18. (Unchanged) The method of claim 14, wherein said mass medium program includes text.

19. (Unchanged) A method of generating and encoding signals to control a presentation, said method comprising the steps of:

receiving a program containing video information;

receiving an instruction, said instruction designating additional program material and having effect at a receiver station to generate at least one receiver specific datum for presentation with said program;

encoding said instruction, including translating said instruction into a control signal, said control signal being operable for directing an ancillary processor to coordinate said at least one of said additional program material and said at least one receiver specific datum with said program; and

storing said control signal in conjunction with said program, said ancillary processor to be operable to control presentation of said program and at least one of said additional program material and said at least one receiver specific datum.

20. (Unchanged) The method of claim 19 wherein said additional program material is stored at the same location as said ancillary processor, and said at least one control signal directs said ancillary processor to generate a video overlay that is coordinated with said video information.

21. (Unchanged) The method of claim 20 further comprising the step of:

transmitting a combined video signal from said program and said video overlay to a plurality of receiver stations.

22. (Unchanged) The method of claim 20 further comprising the step of:

transmitting a combined video signal from said program and said video overlay to a video display.

23. (Unchanged) A method of controlling at least one of a plurality of receiver stations each of which includes at least one of a broadcast and a cablecast signal receiver, at least one processor, a signal detector adapted to receive signals from a transmitter, said processor being programmed to respond to signals from said signal detector, said method comprising the steps of:

receiving at at least one of a broadcast and a cablecast transmitter station at least one instruct signal which is effective at said at least one of said plurality of receiver stations to generate at least one receiver specific datum for presentation in a specific type of programming presentation;

transferring said at least one instruct signal from said at least one of a broadcast and a cablecast transmitter station to at least one transmitter;

receiving at least one control signal at said at least one of said broadcast and said cablecast transmitter station, said at least one control signal designating said at least one of said plurality of receiver stations; and

transferring said at least one control signal to said at least one transmitter, said at least one transmitter transmitting said at least one instruct signal and said at least one control signal to said plurality of receiver stations.

24. (Unchanged) The method of claim 23, wherein one of said at least one instruct signal and said at least one control signal is embedded in a non-visible portion of a television signal.

25. (Unchanged) The method of claim 23, wherein said at least one control signal identifies at least two of said plurality of receiver stations asynchronously, each of said at least two of said plurality of receiver stations receive and respond to said instruct signal asynchronously.

26. (Unchanged) The method of claim 23, wherein a switch communicates signals selectively from said at least one of said plurality of receiver stations and one of a memory and a recorder to said transmitter, said method further comprising one step selected from the group consisting of:

detecting said at least one control signal which is effective at said one of a broadcast and a cablecast transmitter station to instruct communication;

determining a source from which to communicate said signals to said transmitter;

controlling said switch to communicate said signals to said transmitter in response to said at least one control signal which is effective at said transmitter station to instruct communication;

controlling said switch to communicate said signals from a source; and

controlling said switch to communicate to said one of a memory and a recorder, at least one second instruct signal which is effective at said at least one of said plurality of receiver stations to instruct.

27. (Unchanged) The method of claim 23, wherein a controller controls a switch to communicate to said transmitter a selected signal, said method further comprising one step from the group consisting of:

detecting said selected signal which is effective at said one of broadcast and a cablecast transmitter station to instruct;

inputting to said controller said signal which is effective to control said switch;

controlling said switch to communicate said signal according to a transmission schedule;

controlling said switch to communicate from at least one of a plurality of signal sources; and

controlling said switch to communicate signal to at least one of a plurality of transmitters.

28. (Unchanged) The method of claim 23, further comprising one step from the group consisting of:

transmitting to said at least one of said plurality of receiver stations at least one datum designating one of a time and a channel for transmission of said at least one instruct signal or specifying one of the title of and subject matter contained in a unit of mass medium programming and data associated with said at least one instruct signal; and

transmitting to said at least one of said plurality of receiver stations said at least one control signal to cause said at least one of said plurality of receiver stations to tune to a transmission containing a specific one of said at least one instruct signal.

29. (Unchanged) The method of claim 23, wherein said at least one control signal further includes downloadable code targeted to said at least one processor at at least one of said plurality of receiver stations, said downloadable code being effective to program one of the way and the method in which said at least one processor responds to said at least one instruct signal.

30. (Unchanged) The method of claim 23, wherein said at least one of said plurality of receiver stations is adapted to detect at least a portion of said at least one control signal and said at least one instruct signal on the basis of a varying location in an information transmission, said method further comprising the step of transmitting said at least said portion of said at least one control signal and said at least one instruct signal in said varying location.

31. (Unchanged) A method for multimedia programming promotion and delivery for use with an interactive mass medium program output apparatus, said method comprising the steps of:

displaying a mass medium program that promotes multimedia programming, said interactive mass medium program output apparatus having an input device to receive input from a subscriber;

prompting said subscriber during said mass medium program whether said subscriber wants said multimedia programming, said interactive mass medium program output apparatus having an output device for outputting said multimedia programming;

receiving a reply from said subscriber at said input device in response to said step of prompting, said interactive mass medium program output apparatus having a processor for processing said subscriber reply and controlling delivery of said multimedia programming in response to instructions;

delivering said instructions at said interactive mass medium program output apparatus in response to said step of receiving said reply, said instructions being effective for controlling said interactive mass medium program output apparatus;

processing said instructions, said instructions being further effective to generate at least one receiver specific datum for output in a presentation of said multimedia programming; and

presenting said multimedia programming on the basis of said instructions.

32. (Unchanged) The method of claim 31, wherein said instructions are embedded in at least one of a non-visible and a non-audible portion of said mass medium program.

33. (Twice Amended) The method of claim 31, wherein information evidencing at least one of the availability, use and usage of one of said mass medium program and said multimedia programming is at least one of stored and communicated to a remote data collection station, said method further comprising the step of selecting information that one of identifies and designates at least one of:

- (1) a mass medium program;
- (2) a use of programming;
- (3) a transmission station;
- (4) a receiver station;
- (5) a network;
- (6) a broadcast station;
- (7) a channel on a cable system;
- (8) a time of transmission;
- (9) a unique identifier datum;
- (10) a source or supplier of data;

A2
Cont

- A2*
Cont
- (11) a [publication, article, publisher,] distributor[,] or an advertisement;
and
(12) an indication of copyright.
-

34. (Unchanged) The method of claim 31, wherein said instructions include code, said method further comprising the steps of communicating said code to said processor and performing, on the basis of said code, one step selected from the group consisting of:

- (1) receiving a signal containing said multimedia programming;
- (2) actuating one of a video, an audio, and a print output device to output said multimedia programming;
- (3) decrypting at least a portion of said multimedia programming;
- (4) controlling a selective transfer device to communicate said selected specific output to said output device;
- (5) generating a receiver specific datum to present with said multimedia programming; and
- (6) delivering a receiver specific datum at said interactive mass medium program output apparatus one of simultaneously and sequentially with one of said mass medium program and said multimedia programming.

A3
Cont

35. (Twice Amended) A method for promotion and delivery of computer instructions for use with an interactive mass medium program output apparatus, said method comprising the steps of:

displaying a mass medium program promoting at least one computer instruction which is effective to control in a specific type of programming presentation, said interactive mass medium program output apparatus[, said

interactive mass medium program output apparatus] having an input device to receive input from a subscriber;

prompting said subscriber during said mass medium program whether said subscriber wants said at least one computer instruction, said interactive mass medium program output apparatus having a memory for storing at least one of code and a datum;

receiving a reply from said subscriber at said input device in response to said step of prompting, said interactive mass medium program output apparatus having a processor for processing said subscriber reply;

processing said reply from said step of receiving and selecting said at least one of code and said datum designating said computer instructions, said interactive mass medium program output apparatus having a transmitter for communicating subscriber information to a remote site;

communicating said selected at least one of said code and said datum to a remote site;

delivering said at least one computer instruction to said processor; and

generating at least one receiver specific datum for presentation in said specific type of programming presentation on the basis of said delivered at least one computer instruction.

36. (Twice Amended) The method of claim 35, wherein information evidencing one of the availability, the use and the usage of said at least one computer instruction are one of stored at said interactive mass medium program output apparatus and communicated to a remote data collection station, said method further comprising the step of selecting information that one of identifies and designates at least one of:

- (1) a mass medium program;

- A3
could*
- (2) a use of data;
 - (3) a transmission station;
 - (4) a receiver station;
 - (5) a network;
 - (6) a broadcast station;
 - (7) a channel on a cable system;
 - (8) a time of transmission;
 - (9) a unique identifier datum;
 - (10) a source or supplier of data;
 - (11) a [publication, article, publisher,] distributor[,] or an advertisement;
- and
- (12) an indication of copyright.
-

37. (Unchanged) The method of claim 35, wherein said interactive mass medium program output apparatus receives some downloadable code from a remote site, said method further comprising the steps of communicating said downloadable code to said processor and performing, on the basis of said downloadable code, one step selected from the group consisting of:

- (1) receiving a signal containing said at least one computer instruction;
- (2) actuating one of a video, an audio, and a print output device to output at least one of said at least one computer instruction and processed information of said at least one computer instruction;
- (3) decrypting at least some of said at least one computer instruction;
- (4) controlling a selective transfer device to communicate at least some of said at least one computer instruction to one of a storage device and an output device;

(5) generating a receiver specific datum to present with said at least one computer instruction; and

(6) delivering a receiver specific datum at said interactive mass medium program output apparatus one of simultaneously and sequentially with at least one of said mass medium program and said at least one computer instructions.

38. (Unchanged) A method of controlling a receiver station including the steps of:

detecting one of a presence and an absence of at least one of a broadcast and a cablecast control signal;

inputting an instruct-to-react signal to a processor based on said step of detecting;

controlling said processor to output specific information in response to said step of inputting; and

generating at least one receiver specific datum for presentation in a specific type of programming presentation on the basis of information received from said processor based on said step of controlling.

39. (Unchanged) The method of claim 38, wherein a buffer is operatively connected to said processor for buffering input, said method further comprising the step of:

bypassing said buffer and inputting said instruct-to-react signal directly to said processor.

40. (Unchanged) The method of claim 38, wherein said processor processes a datum designating one of a television channel and a television

program, said method further having one step selected from the group consisting of:

controlling a tuner to receive one of a television channel and a television program designated by said processed datum;

controlling a selective transfer device to input to a control signal detector at least some portion of said one of a television channel and a television program designated by said processed datum;

controlling a control signal detector to search for at least one control signal in said one of a television channel and a television program;

controlling a selective transfer device to input to a computer, said at least one control signal detected in said one of a television channel and a television program;

controlling a computer to respond to said at least one control signal detected in said one of a television channel and a television program designated by said processed datum;

controlling a television monitor to display one of video and audio contained in said one of a television channel and a television program;

controlling a video recorder to one of record and play said one of video and audio contained in said one of a television channel and a television program; and

controlling a selective transfer device to communicate to one of a video recorder and a television monitor, said one of a television channel and a television program.

41. (Unchanged) The method of claim 38, wherein said processor processes a datum designating at least one channel of a multichannel signal, said method further having one step selected from the group consisting of:

controlling a converter to receive said at least one specific channels designated by said processed datum;

controlling a selective transfer device to input to a control signal detector at least some portion of said at least one channel designated by said processed datum;

controlling a control signal detector to search for at least one control signal in said at least one channel designated by said processed datum;

controlling a selective transfer device to input to a computer, control signals detected in said at least one specific channels;

controlling a computer to respond to control signals detected in said at least one channel;

controlling a television monitor to one of display video and audio contained in said at least one channel;

controlling a video recorder to one of record and play one of video and audio contained in said at least one channel; and

controlling a selective transfer device to communicate to one of a storage device and an output device said at least one channel.

II. REMARKS

A. Introduction

The Non-Final Office Action dated January 6, 1998 (Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 6, 33, 35 & 36 have been amended and claims 2-41 are pending in the application.

Claims 6-22, 29, 34-37, 40 & 41 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-5, 23-28, 30-33, 38 & 39 are indicated as allowable. Claims 6-22, 29, 34-37, 40 & 41 would be allowable but for the 35 U.S.C. § 112 rejection.

B. Summary of Claim Amendments

Claim 6 has been amended to change a typographical error of "section" to -- station --. Claims 33 & 36 have deleted "publication, article, publisher" from the claim language. Claim 35 has deleted "said interactive mass medium programming output apparatus" in the first step.

C. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Final Office Action paragraph 4.

Paragraph 4 of the Final Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

1. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).¹ Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing,

¹Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

a. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double

patenting).² These two well established types of double patenting use an objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

b. The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes

new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. **The PTO Requirement is Outside the Scope
of 37 C.F.R. § 1.78 (b)**

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with

regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the

Final Office Action's result of abandonment of Applicants' application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

D. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 1/30/96, 2/1/96, 4/5/96 & 4/7/97 and have addressed those specific concerns raised in paragraph 5 of the Final Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 11/3/81,

(4) citation of references apparently unrelated to the subject matter of the claimed invention, and

(5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants'

understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

“[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

**3. References in the Information Disclosure
Statements Subsequent to Applicants' Latest
Effective Filing Date of 9/11/87**

Examiner stated "[n]umerous references listed in the IDS are subsequent to the applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear." Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants' understanding that the effective filing date for the present application is 11/3/81.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is

the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

E. Response to Rejections under 35 U.S.C. § 112

Paragraph 6 of the Non-Final Office Action rejects claims 6-22, 29, 34-37, 40 & 41 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a. Claim 6

receiving at least one control signal at said remote intermediate mass medium transmitter station, said at least one control signal being operable at said remote intermediate mass medium transmitter station to control communication of at least a portion of said mass medium programming and said at least one instruct signal	Page 10 lines 61-63 or page 11 lines 39-41. Page 11 lines 38-43. Page 11 lines 46-57. Page 10 lines 26-28. Page 19 lines 42-44.
transmitting from said remote intermediate mass medium transmitter section at least one information transmission containing said at least a portion of said mass medium programming and said at least one instruct signal, at least said portion of said mass medium programming and said at least one instruct signal being transmitted in accordance with said at least one control signal	Page 11 lines 50-57. Page 19 lines 20-23. Page 19 lines 42-44. Page 11 lines 50-57 with page 11 lines 38-43.

b. Claim 9

wherein said at least one instruct signal comprises downloadable code	Page 4 lines 5-13 with, e.g., "code reader" at page 11 lines 12-14.
---	---

c. Claim 11

transmitting said at least one control	Page 19 lines 60-63 with page 11 lines 38-39 and page 19 lines 14-
--	--

signal from said at least one origination transmitter before a specific time	29. Page 19 lines 63-67.
--	-----------------------------

d. Claim 14

receiving at least one of code and a datum at said transmitter station, said at least one of said code and said datum designating at least one of said at least one instruct signal and said viewer reaction	Page 10 lines 61-63 with page 11 lines 12-14, including "code reader". Page 20-32-33 with page 20 lines 20-28.
--	---

e. Claim 17

wherein said at least one control signal includes downloadable code	Page 11 lines 12-14, including, "code reader" with page 4 lines 5-13.
---	---

f. Claim 19

encoding said instruction, including translating said instruction into a control signal, said control signal being operable for directing an ancillary processor to coordinate said at least one of said additional program material and said at least one receiver specific datum with said program	Page 9 lines 31-33. Page 17 lines 39-44. Page 19 lines 63-67. Page 19 line 30. Page 19 line 67 to page 20 line 2.
--	---

g. Claim 29

wherein said at least one control signal further includes downloadable code targeted to said at least one processor at at least one of said plurality of receiver stations, said downloadable code being effective to program one of the way and the method in which said at least one processor responds to said at least one instruct signal	Page 4 lines 5-13 with page 11 lines 12-14, including "code reader," and page 17 lines 39-46. Page 19 lines 45-53. Page 19 lines 63-67.
--	---

h. Claim 34

wherein said instructions include code, said method further comprising the steps of communicating said code to said processor and performing, on the basis of said code	E.g., page 7 lines 36-58 and page 8 lines 58-62, with page 2 line 66 to page 3 line 3. Page 17 lines 39-46. Page 19 lines 20-29.
---	--

i. Claim 35

displaying a mass medium program promoting at least one computer instruction which is effective to control in a specific type of programming	Page 20 line 16. Page 20 lines 20-22, e.g., line 32 or page 19 lines 48-49 & 63-67. Page 20 lines 48-50.
--	--

presentation, said interactive mass medium program output apparatus having an input device to receive input from a subscriber	Page 20 lines 22-31.
prompting said subscriber during said mass medium program whether said subscriber wants said at least one computer instruction, said interactive mass medium program output apparatus having a memory for storing at least one of code and a datum	Page 20 lines 20-22. Page 20 lines 25-26 or 45. Page 20 lines 24-25 or 46.

j. Claim 37

wherein said interactive mass medium program output apparatus receives some downloadable code from a remote site, said method further comprising the steps of communicating said downloadable code to said processor and performing, on the basis of said downloadable code	E.g., page 22 line 21. Page 19 lines 14-15 with page 2 lines 66-67. Page 18 lines 59-61 or lines 61-63. Page 19 lines 20-29.
---	---

k. Claim 40

wherein said processor processes a datum designating one of a television channel and a television program	Page 19 lines 14-15 with lines 20-23.
---	---------------------------------------

l. Claim 41

wherein said processor processes a datum designating at least one channel of a multichannel signal	Page 19 lines 14-15 with lines 20-23
--	--------------------------------------

Applicants respectfully submit that claims 2-31 of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to

enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited specification support and the amendments to the claims are sufficient to overcome the rejections under 35 U.S.C. § 112, first paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.